

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed October 16, 2006. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Discussion of Claim Rejections Under 35 U.S.C. § 103(a)**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

**A. Rejection of Claims 1-7, 12-15, 18, 21, 26-29, and 32**

Claims 1-7, 12-15, 18, 21, 26-29, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* (U.S. Patent No. 5,726,897) in view of *Gleason* (U.S. Pat. No. 5,091,777). Applicant respectfully traverses this rejection.

*Tammi* discloses a mail assembly system wherein non-printable post processing data is embedded within mail statement print data and used to control "post processing" of mailing pieces. *Tammi*, column 3, lines 18-22. As described by *Tammi*, data records comprising mailing statement print data (which comprise the embedded post processing data) are stored in a data storage means. *Tammi*, column 3, lines 23-32. During operation of *Tammi*'s system, a printer receives a stream of mailing statement print data and sequentially outputs printed sheets according to the print data. *Tammi*, column 5, lines 23-28. During that process, the embedded post processing data is split off from the stream of statement print data by a "splitter device" and is directed to a "system controller computer." *Tammi*, column 5, lines 28-34.

As the printed sheets are output by the printer, each printed sheet is transferred to a "post processing system" by a "finishing interface". *Tammi*, column 5, lines 34-37. *Tammi* states that the finishing interface sends signals to the system controller computer: (a) when each printing sheet is transferred to the post processing system by the finishing interface, and (b) when a final printed sheet of each mailing statement clears the finishing interface and enters the post processing system. *Tammi*, column 5, lines 37-49. The

system controller computer then uses those signals to match the parity of the post processing data received from the splitter device with the parity of the mailing statement to direct the post processing operations carried out by the post processing system for each mailing piece. *Tammi*, column 5, lines 56-62. Tammi states that the “post processing” of the printed sheets includes folding the sheets, inserting them into envelopes, sealing the envelopes, etc. *Tammi*, column 5, lines 16-22.

Significantly, nowhere does Tammi state that signals are provided to the system control computer after post processing is completed. Instead, as is apparent from the above, signals are only provided to the system controller computer so that the computer can control such post processing. Therefore, the signals provided to the system controller computer do not identify that any statements or other documents have been folded and sealed.

In view of the above, Applicant submits that Tammi does not teach or suggest the limitations that the Examiner argues Tammi teaches. Regarding independent claim 1, Tammi does not teach or suggest “determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing”. Tammi instead only teaches determining that printed sheets of mailing statements have “entered” a post processing system. Tammi describes no determination that folding and/or sealing later occurred. As a further point, Tammi does not teach or suggest “generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing”. Again, Tammi’s system controller computer only receives

signals in regard to entry of printed sheets into the post processing system, *not* as to any folding and/or sealing operations.

Regarding independent claim 12, Tammi does not, as is argued by the Examiner, teach “means for determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing” or “means for generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that the document has been printed, folded, and sealed as a mailing” at least for reasons described above in relation to claim 1.

Regarding independent claim 18, Tammi does not, as is argued by the Examiner, teach a “print-to-mail device” comprising “hard copy generation hardware”, “a folding mechanism”, and “a sealing mechanism”. As described above, Tammi only teaches a printer and a *separate* post processing system. Furthermore, Tammi does not teach a print-to-mail notifier configured to generate notification information pertinent to “generating of print-to-mail documents that have been printed, folded, and sealed by the print-to-mail device as a mailing”. Again, Tammi’s system controller computer only receives signals in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations.

Regarding independent claim 28, Tammi does not, as is argued by the Examiner, teach device comprising “a print engine configured to print documents”, “a folding mechanism configured to fold the printed documents”, and “a sealing mechanism configured to seal the folded documents”. Again, Tammi only teaches a printer and a *separate* post processing system. Furthermore, Tammi does not teach a print-to-mail notifier configured to generate a notification that confirms “generation of

multiple print-to-mail format documents and thereby confirms printing, folding, and sealing of the multiple documents as mailings". Again, Tammi's system controller computer only receives signals in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations. Moreover, Tammi does not teach that "the mailings do not require an envelope to be mailed". To the contrary, as described above, Tammi explicitly states that the printed "sheets" *are* placed in envelopes in order to mail them. Therefore, Tammi fails to teach "print-to-mail format documents" as defined by Applicant.

Given that Gleason does not provide teachings or suggestions that would remedy the shortcomings of the Tammi disclosure, Applicant submits that independent claims 1, 12, 18, and 28, and their dependents, are allowable over the Tammi/Gleason combination.

In the final Office Action, the Examiner reiterates his argument that Tammi teaches "determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing" and cites column 9, line 44 to column 10, line 35 and states that that portion of the Tammi reference "precisely teaches in a sensing means that senses or determines if certain processes in a post processing system were done." The cited portion of the Tammi reference provides as follows:

Means for post processing a plurality of mailing pieces are preferably furnished with the invention in the form of a post processing system 70. Post processing system 70 generally includes one or more conventional mail post processing devices such as a collator 75 for collating the printed sheets of mail or billing statements transferred thereto from printer system 20, a buckle folder 80 for folding collated statements,

an inserter apparatus 85 which includes a plurality of insert hoppers (not shown) for providing selective inserts to each statement, an envelope wetting and sealing apparatus 90 for sealing the stuffed envelopes, and a postage metering device 95. Additional devices for providing additional post processing operations may be included within post processing system 70. Alternatively, post processing system 70 may contain fewer devices and apparatus than are shown in FIG. 1.

Post processing system 70 is interfaced with system controller computer 60 by means of a plurality of communication links, shown generally as communication links 100a-c. Post processing operations by post processing system 70 are directed and controlled by system controller 60 by use of controlling software associated with system controller 60 and according to the retrieved post processing data received by system controller computer 60 from splitter device 45. Control instructions from system controller 60 are directed to post processing system 70 via communication links 100a-c.

A plurality of sensor or sensing means are preferably employed to monitor the post processing operations carried out by post processing system 70, and are shown generally as sensors 105a-c, positioned in association with communication links 100a-c respectively. The sensors 105a-c utilized with the invention preferably comprise conventional optical and electronic sensing means. For example, the position of each mail statement within post processing system 70 is generally tracked by encoder sensor means which provide for keeping track of the machine cycle of each device 75-95 within the post processing system 70, and thus the position or location of printed mail statements. The encoder means may comprise shaft encoders (not shown) located on a drive shaft or timing shaft (not shown) of each device 75-95, or an encoder located within the electric motors or other driving means (not shown) which drive the devices 75-79. The sensing means preferably also comprises a plurality of photocells (not shown) which track and monitor the movement

and location of each printed mail statement as it moves through the devices 75-95 of post processing system 70. The aforementioned sensing means used in association with post processing of mail materials are standard and are well known to persons of ordinary skill in the art, and thus need not be described further in this disclosure. Note, however, that scanning means for detecting printed machine readable codes on mail statements are not included in the above sensing means, as such scanning means and printed codes are not required with the invention for control of post processing operations. Note also, however, that scanning means could be used in conjunction with the invention for form verification or other applications unrelated to post processing.

*Tammi*, column 9, line 44 to column 10, line 35. As can be appreciated from the above, *Tammi* does not provide a teaching of determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing. Instead, *Tammi* only discloses "sensing means" of the post processing system that track the machine cycles of the system. Nowhere is it actually stated that any determination of whether a print-to-mail format document was generated is made.

The Examiner acknowledges in the final Office Action that *Tammi* fails to teach a print-to-mail format document but points to Applicant's Background section as admitting that such documents are known. Applicant responds by noting that, even if it is assumed that print-to-mail format documents are known, the Examiner has identified absolutely no suggestion or motivation in the prior art to modify *Tammi*'s system to process such documents. In other words, just because print-to-mail format documents are known does not automatically mean that it would have been obvious to someone having ordinary skill in the art to do away with *Tammi*'s standard documents and

Tammi's entire post processing system. Indeed, such a modification seems contrary to Tammi's disclosure, which places significant emphasis on the existence and functioning of the post-processing system. Regardless, given that the Examiner has not identified any suggestion or motivation, the Examiner has failed to state a *prima facie* case for obviousness. See MPEP § 2143.

**B. Rejection of Claims 8-10, 16, 19, 24, 25, 30, and 31**

Claims 8-10, 16, 19, 24, 25, 30, and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* in view of *Gleason* in view of *Stewart* (U.S. Pat. No. 6,714,964). Applicant respectfully traverses this rejection.

As identified above, Tammi and Gleason do not teach several aspects of Applicant's claims. In that Stewart does not remedy the deficiencies of the Tammi and Gleason references, Applicant respectfully submits that claims 8-10, 16, 19, 24, 25, 30, and 31 are allowable over the Tammi/Gleason/Stewart combination for at least the same reasons that claims 1, 12, 18, and 28 are allowable over Tammi/Gleason.

**C. Rejection of Claims 11 and 17**

Claims 11 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* in view of *Gleason* in view of *Pollard* (U.S. Pat. No. 5,745,590). Applicant respectfully traverses this rejection.

As identified above, Tammi and Gleason do not teach several aspects of Applicant's claims. In that Pollard does not remedy the deficiencies of the Tammi, Gleason, and Stewart references, Applicant respectfully submits that claims 11 and 17

are allowable over the Tammi/Gleason//Pollard combination for at least the same reasons that claims 1 and 12 are allowable over Tammi/Gleason.

**D. Rejection of Claims 33, 34, and 35**

Claims 33, 34, and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Tammi* in view of *Gleason*, *Pollard*, and the Applicant's admitted prior art ("AAPA"). Applicant respectfully traverses this rejection.

As identified above, Tammi, Gleason, and Pollard do not teach several aspects of Applicant's claims. In that no admissions by Applicant remedy the deficiencies of the Tammi, Gleason, and Pollard references, Applicant respectfully submits that claims 33, 34, and 35 are allowable for at least the same reasons that claims 1, 12, and 18 are allowable over Tammi/Gleason/Pollard.

**II. Discussion of Examiner's Response to Arguments**

In the Response to Arguments section of the Office Action the Examiner states that Tammi does actually disclose "determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing", and cites column 10, lines 9-15 of the Tammi reference for support. Applicant disagrees.

Column 10, lines 9-15 of the Tammi reference only state that the position or location of a "printed mail statement" is determined. Applicant notes that a "printed mail statement" as used in the Tammi reference simply describes a printed statement that is to be mailed, i.e., a printed bill that can later be placed into an envelope and mailed to a customer. That "statement," however, is not ever described by Tammi as comprising a

"print-to-mail format document" that has been generated by printing, folding, and sealing. Instead, Tammi explicitly discloses that the statements are *placed in envelopes*. See *Tammi*, column 5, lines 16-22.

Applicant further notes that the Examiner cannot disregard the "print-to-mail format" limitation. As described by Applicant in the specification, such a format pertains to a document that can be mailed *without* the need of an envelope. For example, Applicant states:

The print-to-mail device 204 comprises any device that is capable of print-to-mail functionality, *i.e.*, that is capable of printing documents in a format designed for direct mailing without the need for an envelope. Although the term "print-to-mail device" is used herein, it is to be understood that the disclosure is not limited to any particular type of device that provides this functionality. Accordingly, the term is intended to include any appliance or printing device (*e.g.*, printer, photocopier, facsimile machine, multifunction peripheral (MFP), *etc.*) that either inherently provides this functionality or which provides it when a suitable print-to-mail accessory is used in conjunction therewith. An example of a suitable print-to-mail device is a print-to-mail appliance available under the name Print to Mail™ Accessory from the Hewlett-Packard Company.

*Applicant's specification*, page 5, lines 3-13. Therefore, Applicant's specification explicitly defines "print-to-mail format document" as a document that is in a format for "direct mailing *without the need for an envelope*". Applicant further noted the fact that the current technology lack the capability to report as to the status of such a print-to-mail format document:

Although the print-to-mail devices work well for their designated purposes, current systems do not provide identification of which print-to-mail format documents have been generated. Accordingly, where the documents are bills that are to be sent to clients, there presently is no way to track which bills have been generated and mailed beyond having a person manually record this information. This can lead to billing problems. For instance, it can be easy for the user to (e.g., business) send extra copies of the same bill to a client, or not send a bill to the client at all. Clearly, both situations are undesirable and can potentially create problems in terms of client relations.

*Applicant's specification*, page 2, lines 1-9. Accordingly, Applicant provides an explicit definition as to what a "print-to-mail format document" is that cannot be disregarded. Applicant notes that it is well established in the law that claim terms are to be *interpreted in light of the specification*. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) ("Claims must be read in view of the specification, of which they are a part"). Given that none of the references contemplate print-to-mail format documents, the rejection fails to teach or suggest all claim limitations.

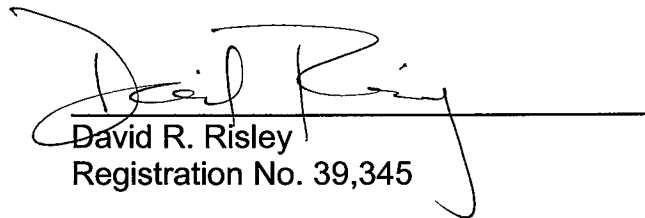
As for the Examiner's statement that "the last process performed on the print-to-mail document is sealing," Tammi does not state that such sealing is performed on Tammi's printed mail statement. Again, Tammi states that the statement is folded and merely placed in an envelope that will be mailed. Furthermore, and perhaps more significant, Tammi does not describe creating any notifications after the printed mail statements are placed in envelopes and sealed in them. Instead, as described above, Tammi only states that a finishing interface sends signals to the system controller

computer: (a) when each printing sheet is *transferred to* the post processing system by the finishing interface, and (b) when a final printed sheet of each mailing statement clears the finishing interface and enters the post processing system. *Tammi*, column 5, lines 37-49. Given that the “post processing” comprises the folding, the placing of the statements in envelopes, and the sealing of the envelopes, it follows that Tammi’s notification is not a notification that a “print-to-mail format document” has been printed, “folded”, and “sealed as a mailing”. Instead, the notification only indicates that printing has been completed and folding and placement in an envelope *may* next occur. In other words, because the notification is sent when a printed statement is *passed to* the post processing system, no notification is provided that the later post processing actually occurred. That is precisely the problem that Applicant identified in the specification. Specifically, there is no way to track that complete mailings have been generated. Instead, only the fact that a bill was printed is tracked by current systems. Therefore, even if one assumed that Tammi’s “statements” were print-to-mail format documents, the references would still fail to meet Applicant’s claims, which require notification that a document has not only been printed, but also folded and sealed.

### **CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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